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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,454	09/11/2003	Thomas A. Victorian	899.072US1	4911
21186 7590 05/20/2008 SCHWEGMAN, LUNDBERG & WOESSNER, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402				
EXAMINER				
LAO, LUN S				
ART UNIT		PAPER NUMBER		
2615				
MAIL DATE		DELIVERY MODE		
05/20/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 10/660,454	Applicant(s) VICTORIAN ET AL.
Examiner LUN LAO	Art Unit 2615

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 April 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Vivian Chin/
Supervisory Patent Examiner, Art Unit 2615

Continuation of 11, does NOT place the application in condition for allowance because: Regarding applicant argued that the combination of Nemirovski and Anderson is improper and office action does not set forth a proper case of obviousness because the cited portions of Nemirovski and Anderson, individually or in combination, do not provide the claimed subject matter (see the remarks page 11 first and second paragraph).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Nemirovski and Anderson both teach a hearing device using an ear canal. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Anderson into the teaching of Nemirovski so that the hearing aid taught by Nemirovski would have been less weight and saving space. On the other hand, Nemirovski teaches the housing 30 can be custom designed for the individual to form a close and comfortable fit with the ear of the individual (see col. 6 line 23-57). One of ordinary skill in the art would modify Nemirovski's system by housing its communication device 14 into an earmold housing such as the one provided by Anderson (see the final rejection for claim 1).

Applicant argued that Applicant is unable to find in the cited portions of Nemirovski and Anderson, among other things, a wireless transmitter to transmit a first wireless signal representing an occluded sound, and an earmold housing the wireless transmitter, as recited in claim 1 (see the remarks page 11 second paragraph).

The examiner disagrees. Nemirovski teaches a processor (24 in fig.3), connected to the first microphone (20), to process the occluded sound (the sound block by housing 30, see fig. 3); a wireless transmitter (14 in fig. 1), connected to the processor (24 in figs. 3-4), to receive the processed occluded sound from the processor and transmit a first wireless signal representing the occluded sound (see figs. 1-3 and col. 6 line 4 and col. 7 line 51); and Anderson teaches an earmold housing (10 in fig.1) the first microphone (12), the processor, and the wireless transmitter (13 in fig. 1), the earmold configured for use as an in-the-ear (ITE) device (see fig. 1 and col. 3 line 52-col. 4 line 25). The combination meets the limitation as recited in claim 1.

Applicant further argued that Applicant respectfully traverses the rejection and submits that the office action does not set a proper case of obviousness because the cited portions of Nemirovski and Dar, individually or in combination, do not provide the claimed subject matter. For example, Applicant is unable to find in the cited portions of Nemirovski and Dar, among other things, a behind-the-ear (BTE) module including a wireless transmitter to transmit a first wireless signal representing an occluded sound, as recited in claim 14 (see the remarks page 12, second-4th paragraph).

The examiner disagrees. Nemirovski disclose that a processor (24 in fig.3), connected to the first microphone (20), to process the occluded sound; and a wireless transmitter (14 in fig.1), connected to the processor (24), to receive the processed occluded sound from the processor and transmit a first wireless signal representing the occluded sound (the sound block by housing 30, see fig. 3) (see fig. 3 and see col. 6 line 4 and col. 7 line 51); and Dar teaches that a behind-the-ear (BTE) module attached to the ITE module (see figs 2A-2B, 3).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Nemirovski and Dar both teach a hearing device using an ear canal. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Dar into the teaching of Nemirovski so that the hearing aid taught by Nemirovski would have more space for battery compartment for longer power and provide more choices to the user to choose the battery locating at the BTE compartment or ITE compartment or both. On the other hand, Nemirovski teaches the housing 30 can be custom designed for the individual to form a close and comfortable fit with the ear of the individual (see col. 6 line 23-57). One of ordinary skill in the art would modify Nemirovski's system by housing its communication device 14 into a BTE such as the one provided by Dar. Therefore, the combination is proper and meets the limitation as recited in claim 14.

Applicant further argued that Applicant respectfully traverses. The combination of Nemirovski, Brander, and Dar is improper; and Nemirovski, Brander, and Dar, individually or in combination with each other, do not provide the claimed subject matter. For example, Applicant is unable to find in the cited portions of Nemirovski, Brander and Dar, among other things, a first ear-level device being one of a behind-the-ear (BTE) device and an in-the-ear (ITE) device, as recited in claim 26 (see the remark page 13, 3rd-4th paragraph).

The examiner disagrees. Nemirovski teaches a system (see fig.3) adapted for use in a first ear having a first ear canal and a second ear having a second ear canal, comprising: a first ear-level device including: a first microphone (20) adapted for use in the first ear canal, the first microphone receiving an occluded sound from about the first ear canal; a first processor (24), connected to the first microphone, to convert the occluded sound to a first electrical signal; and a wireless transmitter (14), connected to the first processor (24), to receive the first electrical signal and transmit a first wireless signal representing the occluded sound (see col. 6 line 4 -col. 7 line 51); and Brander teaches a second ear-level device including (see fig.1): a wireless receiver (20) to receive a second wireless signal representing a remote sound; a second processor (18), connected to the wireless receiver, to convert the second wireless signal to the remote sound; and a speaker (10) connected to the second processor, the speaker adapted for use in the second ear canal to transmit the remote sound to the second ear canal (see fig.3 and see col. 3 line 25-col. 4 line 67); and Dar teaches that the first and second ear-level devices are each one of a behind-the-ear (BTE) device (see fig.3, (50) and an in-the-ear (ITE) device (40 and see col. 4 line 13-37).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Nemirovski, Brander and Dar both teach a hearing device using an ear canal. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Brander into the

teaching of Nemirovski so that the hearing aid taught by Nemirovski would have been compact. On the other hand, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Dar into the teaching of Nemirovski so that the hearing aid taught by Nemirovski would have more space for battery compartment for longer power and provide more choices to the user to choose the battery locating at the BTE compartment or ITE compartment or both. On the other hand, Nemirovski teach the housing 30 can be custom designed for the individual to form a close and comfortable fit with the ear of the individual (see col. 6 line 23-57). One of ordinary skill in the art would modify Nemirovski's system by housing its communication device 14 into a BTE such as the one provided by Dar. Therefore, the combination is proper and meets the limitation as recited in claim 26.